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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/719,559 | 03/02/2001 | Reinhard Plaschka | JEK/PILASCHKA | 3460 |

7590

03/28/2002

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EXAMINER

FERGUSON, LAWRENCE D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1774

DATE MAILED: 03/28/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Applicati n No. | | Applicant(s) | |
| | 09/719,559 | | PLASCHKA ET AL. | |
| | Examiner | | Art Unit | |
| | Lawrence D Ferguson | | 1774 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections – 35 USC 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In Claims 1 and 11-12, “such as” and “or the like” are indefinite.
- b. In Claims 1 and 12, “the surfaces” lacks antecedent basis.
- c. In Claim 4, “low concentration” is a relative term, therefore rendered indefinite.
- d. In Claim 7, “in particular” is indefinite.
- e. In Claims 2, 6 and 8, the term “preferably” is a relative term which renders the claim indefinite.
- f. In Claim 12, “e.g.” is indefinite.

Claim Rejections – 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-2, 4-6, 9-17 are rejected under 35 U.S.C. 103(a) as being obvious over Edwards (U.S. 5,388,862).

5. Edwards discloses a security article such as a banknote or identity card (abstract) having printed thereon a design, lettering or pattern comprising printed characters (column 1, lines 30-31) which conventionally consist of special effect print that is not readily visible without a vision aid as taught in column 1, lines 35-37. Edwards discloses security paper with a light-transmitting coating bonded to a second coating (column 3, lines 4-9) being luminescent, providing mechanical protection where the coatings provide adhesive properties to bond the security element into paper (column 4, lines 57-59). Edwards discloses the security paper comprising thread (column 6, lines 38-41). Although Edwards does not explicitly disclose a coating weight, coating weight is optimizable. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range is of routine skill in the art. Edwards does not disclose the paper layer produced in a paper machine. It would have been obvious to one of ordinary skill in the art to make the paper in a paper machine because this is a well-known process within the art.

Claim Rejections – 35 USC § 103(a)

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being obvious over Edwards (U.S. 5,388,862) in view of Howland et al. (U.S. 5,868,902).

7. Edwards is relied upon for claims 1-2, 4-6 and 9-17. Edwards does not disclose acrylates as a component in the composition. Howland teaches security paper with a coating (abstract) where the binder of the coating comprises acrylated material (column 9, lines 56-62). Edwards

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and Howland are analogous art because they are from the same field of security paper. It would have been obvious to one ordinary skill in the art to include the acrylated material in the coating of Edwards because Howland teaches this material increases the resistance of the coating from environmental elements such as water.

Claim Rejections – 35 USC § 103(a)

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being obvious over Edwards (U.S. 5,388,862) in view of Detrick et al. (U.S. 5,161,829).

9. Edwards is relied upon for claims 1-2, 4-6 and 9-17. Edwards does not disclose the security paper consisting of cotton fibers. Detrick teaches security paper formed of cotton fiber (column 3, lines 57-60). Edwards and Detrick are analogous art because they are from the same field of security paper. It would have been obvious to one ordinary skill in the art to include the cotton fiber in the security paper of Edwards because Detrick teaches this component produces improved printability and feel of the security paper.

Claim Rejections – 35 USC § 103(a)

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being obvious over Edwards (U.S. 5,388,862) in view of Howland et al. (U.S. 6,063,239).

11. Edwards is relied upon for claims 1-2, 4-6 and 9-17. Edwards does not disclose the security paper consisting of polyamide fibers. Howland teaches security paper (abstract) comprising polyamide fibers (column 1, lines 49-50). Edwards and Howland are analogous art


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because they are from the same field of security paper. It would have been obvious to one ordinary skill in the art to include the polyamide fiber in the security paper of Edwards because Howland teaches the polyamide fiber improves durability of the security paper.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.


Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISOR PATENT EXAMINER
TECHNOLOGY CENTER 1700

